FILE COPY

Office-Supreme Court, U.S.
FILED
NOV 9 19
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 522

VACO PRODUCTS CO.,

Petitioner,

vs.

AMP INCORPORATED,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

ALBERT L. KEGAN,
79 West Monroe Street,
Chicago 3, Illinois,
Counsel for Petitioner.

THE SMITHCRAFT-MARDEN PRINTING COMPANY, CHICAGO

INDEX.

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Constitutional Provision Involved	2
Statute Involved	3
Statement of the Case	3
Reasons for Granting the Writ	6
1. The Court of Appeals for the Seventh Circuit has adopted and applied a standard of patentability so low as to conflict with the constitutional standard, as announced and applied by this Court	6
2. The Court of Appeals for the Seventh Circuit has again rejected this Court's determination of the constitutional standard of patentability, which calls for the exercise of this Court's power of supervision	6
3. It is a matter of prime public importance that there be one law of the land, in patent as in other matters, and that the inferior federal courts obey and apply it	6
Argument	7
Conclusion	11
Appendix	13
Opinion of the Court of Appeals	13
Judgment of June 28, 1960 of the Court of Appeals	20
Order of August 12, 1960 of the Court of Appeals denying rehearing	21
Order of August 12, 1960 of the Court of Appeals denying rehearing en banc	22

ILLUSTRATIONS.

The Wenger tool	facing p. 4
The Stevens tool	facing p. 10

Citations.

Cases.

A & P (Great A. & P. Tea Co. v. Supermarket Equipment Co.), 340 U. S. 147 (1950) 2, 6, 7, 8

Chicago Steel Foundry Co. v. Burnside Steel Foundry Co., 132 F. 2d 812 (7 Cir., 1943) 8

Crest Specialty v. Trager, 341 U. S. 912 (1951) 8

Falkenberg v. Bernard Edward Co., 175 F. 2d 427 (7 Cir., 1949) 8

Great A. & P. Tea Co. v. Supermarket Equipment Co., 340 U. S. 147 (1950) 2, 6, 7, 8

Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U. S. 425 (1894) 7

Shenfield v. Nashawannuck Mfg. Co., 137 U. S. 56 (1890) 7

Sinclair & Carroll Co., Inc. v. Interchemical Corp., 325 U. S. 327 (1945) 7

Statutes.

28 U. S. C., Sec. 1254 (1) 2

28 U. S. C., Sec. 1338 (a) 3

35 U. S. C., Sec. 102 (a), Conditions for Patentability: Novelty and Loss of Right to Patent 3

35 U. S. C., Sec. 103, Conditions for Patentability: Non-obvious Subject Matter 2, 3, 11

Constitution.

Article 1, Section 8, Clause 8 2

Abbreviations Used.

App. Pet.	Appendix to this petition
Def. App.	Defendant's (petitioner's) appendix
Exh.	Exhibit
Pl. App.	Plaintiff's (respondent's) appendix
Pl. R. App.	Plaintiff's (respondent's) reply appendix

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. .....

VACO PRODUCTS CO.,

Petitioner,

vs.

AMP INCORPORATED,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above entitled case on June 28, 1960.

OPINIONS BELOW.

The District Court gave no opinion. Its judgment, findings of fact and conclusions of law are reported in 178 F. Supp. 496 (D. C. Ill. 1959) and appear at Pl. App. 3a-7a. Respondent's appeal involved only findings 10, 11 and 12, set forth in the margin at page 5 hereof.

The opinion of the Court of Appeals is reported in 280 F. 2d 518 (7 Cir., 1960) and is appended hereto (App. Pet. 13).

JURISDICTION.

The judgment of the Court of Appeals was made and entered on June 28, 1960 (Appeal 12835: App. Pet. 20). Orders denying rehearing and denying rehearing *en banc* were made and entered on August 12, 1960 (App. Pet. 21, 22).

The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

QUESTIONS PRESENTED.

1. May a pair of ordinary pliers with a pair of aligned holes in its overlapping jaws, patented to shear smooth rods, be repatented as a new combination for shearing *threaded* rods (screws and bolts) 79 years after the original patent has expired thereon, merely because the shape of one of the holes has been changed from smooth to threaded to accommodate the screw which is to be shortened in the tool?

2. May a Court of Appeals establish a standard of patentability for its circuit so low as to extend patent monopolization to the concept of making a hole fit an object intended to be inserted therein, in the teeth of the constitutional standard pronounced by this Court in *Great A. & P. Tea Co.* v. *Supermarket Equipment Co.*, 340 U. S. 147 (1950)?[1]

3. Is ingenuity still a prerequisite to patentability, in view of Section 103 of the Patent Act of 1952?

CONSTITUTIONAL PROVISION INVOLVED.

Article 1, Section 8, Clause 8: The Congress shall have Power * * * to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective writings and discoveries.

---

1. Hereinafter referred to as *A. & P.*

STATUTE INVOLVED.

35 U. S. C. § 102. **Conditions for Patentability; Novelty and Loss of Right to Patent**—A person shall be entitled to a patent unless—

(a) the invention was * * * patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent * * * (July 19, 1952, c. 950, § 1; 66 Stat. 797).

35 U. S. C. § 103. **Conditions for Patentability; Non-Obvious Subject Matter**—A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * * (July 19, 1952, c. 950, § 1; 66 Stat. 798).

STATEMENT OF THE CASE.

Federal jurisdiction is based on 28 U. S. C., § 1338(a). In 1855 Grover patent No. 13,570 issued, showing a hand tool for cutting pieces off the ends of wire rods. The tool resembled ordinary pliers, but had a pair of tubular holes in its overlapping jaws, which holes aligned when the handles of the pliers were separated, so that a piece of rod or wire could be passed through both holes. When the pliers handles were squeezed together, the holes sheared past each other, thereby cutting a piece off the end of the rod or wire. The Court of Appeals correctly stated:

> "It [the Grover tool] could have been used to cut [the ends off] screws but, if so used, it would result in flattening the outer edges of the threads of the screw

so that the threads would have to be 'dressed' before the screws could be used."[2]

Since about 1935,[3] it has been the common, usual practice of mechanics, when filing or cutting a screw, to retain it in a nut or similar threaded aperture which conforms to and supports the thread of the screw, to prevent the working force from flattening the thin edges of the screw against a flat surface. All that was necessary, therefore, to prevent Grover from flattening screw threads was to conform its screw-receiving hole to the shape of screws.

Respondent's assignor Wenger did this in 1948, and filed a patent application containing Figures 1 and 2, reproduced herewith. Each dotted circle in Fig. 2 indicates that the hole 6 which it surrounds is threaded. Each threaded hole 6 in the upper jaw can hold a threaded bolt or screw so that its end will protrude into the corresponding smooth hole 7 in the lower jaw and be broken off when the pliers handles 4 and 2 are squeezed together.[4] If the holes 6 in the upper jaw are not threaded, the device becomes the 1855 Grover rod cutter.[5] In 1951, seventy-nine years after the Grover patent had expired, Wenger patent 2,560,318 issued, with the aforesaid Figures 1 and 2.

2. App. Pet., 16; 280 F. 2d 518, 520.
3. Pl. App. 39a; Def. App. 13.
4. *Cf.* physical exhibits sent up, Def. Exhs. 2 and 29, Pl. Exh. 7.
5. *Cf.* physical exhibits, Def. Exhs. 2 and 18a.

July 10, 1951 F. J. WENGER 2,560,318

TOOL

Filed July 6, 1948

Fig. 1.

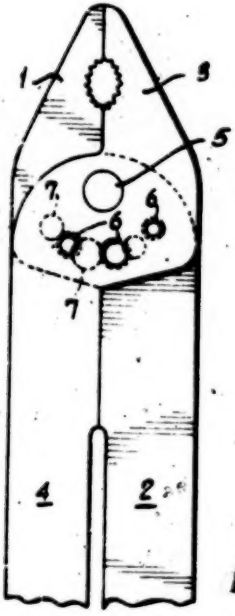
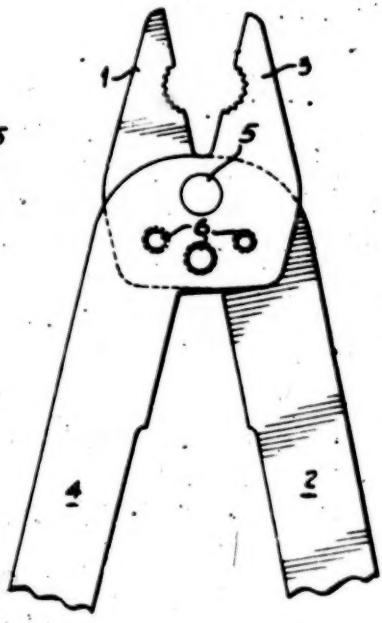


Fig. 2.



Respondent sued petitioner, who admitted that it infringed the patent if it was valid. Hence the sole issue is the *validity* of the Wenger patent, and that issue turns on the question whether the Constitution permits the Court of Appeals for the Seventh Circuit to reject the standard consistently imposed by this Court and in its place set a standard of patentability for its circuit so lax that a trivial, commonplace change in the shape of one hole amounts to "inventive genius" sufficient to reinstate, after 79 years, a patent monopoly upon the entire combination comprising the tool, of which the hole is but one part.

The District Court found that it did not require patentable inventiveness to add the commonplace screw thread to a circular hole whenever it was decided to use the hole to support a threaded object instead of a smooth one. The District Court made appropriate formal findings of fact,[6] on which it adjudged the Wenger patent to be invalid (Pl. App. 3a).

The Court of Appeals concluded that the District Court had not applied a sufficiently lenient standard of patentability, and reversed, relying on supposed commercial success and the long period of time intervening between the

6. Pl. App. 4a-7a. The three findings challenged on appeal were:

"10. The sole difference between the Grover prior art tool, United States Patent No. 13,570, and the plaintiff's patented tools is the threaded groove in one of the holes, and that difference does not amount to non-obvious subject matter. There is no invention in adding screw threads to a circular hole.

"11. The subject matter patented to the plaintiff is the substitution of the threaded hole of an ordinary nut for the smooth hole in the Grover patent of 1855. Plaintiff's tool did not obtain a new and unexpected result and is merely the application of a well known tool by known means, a threaded hole, to an analogous purpose and such application is not a new invention.

"12. The new use of the threaded hole is so nearly analogous to the former use that the applicability of the device to such use would occur to a person of ordinary mechanical skill and is the adoption of a well known mechanical expedient within the ordinary skill of the art."

Grover and the *Wenger* patents. Its Opinion ignores the *A. & P.* case.[7]

REASONS FOR GRANTING THE WRIT.

1. The Court of Appeals for the Seventh Circuit has adopted and applied a standard of patentability so low as to conflict with the constitutional standard, as announced and applied by this Court.

2. The Court of Appeals for the Seventh Circuit has again rejected this Court's determination of the constitutional standard of patentability, which calls for the exercise of this Court's power of supervision.

3. It is a matter of prime public importance that there be one law of the land, in patent as in other matters, and that the inferior federal courts obey and apply it.

7. 340 U. S. 147 (1950).

ARGUMENT.

The rule of law imposed on the district courts of the Seventh Circuit by the instant decision is that anything is patentable if it is as unobvious as the selection[8] of a square hole to receive a square peg, in the light of prior teaching that a round peg is to be fitted into a round hole. For the court below has held that it is patentably unobvious to provide a threaded hole to receive and support a screw, *just because* mechanics for many years have used an unthreaded hole to receive and support unthreaded objects.

The concurring opinion in *A. & P.*[9] includes two cases showing how this Court has long repudiated patentability based upon changes in form of the character here in issue:

Flat cord is not patentable over round cord, for the loop at the end of suspenders. *Shenfield* v. *Nashawannuck Mfg. Co.*, 137 U. S. 56 (1890).

An oval toilet paper roll is not patentable over the round roll, although the oval shape facilitates tearing off strips. *Morgan Envelope Co.* v. *Albany Perforated Wrapping Paper Co.*, 152 U. S. 425 (1894).

And *A. & P.*[10] itself holds that an elongated cashier's counter is not patentable over the counter without the extension, despite increased utility, long-felt want, genuine commercial success, and copying by the petitioner.

This Court reversed the Court of Appeals for the Seventh Circuit for holding a trough and discharge chute disguised as a toy pig to be patentable over a similar undisguised

8. Mere selection is not patentable.' *Sinclair & Carroll Co., Inc.* v. *Interchemical Corp.*, 325 U. S. 327 (1945).

9. 340 U. S. 147, at 157, 158 (1950).

10. 340 U. S. 147 (1950).

device, although the former mimicked eating and thereby encouraged an infant to eat, while the latter did not. *Crest Specialty* v. *Trager*, 341 U. S. 912, 913 (1951).

The Court of Appeals for the Seventh Circuit has previously undertaken to expressly "reject" the constitutional standard of patentability as defined by this Court:

> *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812, at 817 (7 Cir., 1943).
>
> *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427, at 428-9 (7 Cir., 1949).

In the Opinion below[11], the Court of Appeals rejects *A. & P. sub silentio*. Moreover, only surmise and conjecture supply the commercial success and long-felt want which the Court of Appeals relied on to reverse the trial court.

(a) The trial court refused to find commercial success. The Court of Appeals surmised it from respondent's current sales of approximately 150,000 tools annually,[12] in the complete absence of evidence whether this was a significant or insignificant sales volume in the hand tool industry. Furthermore, this sales figure applies to a combination tool which includes crimping pliers for affixing electrical terminals to wire without soldering, a wire cutter, a wire stripper, a stripping gage, a stud gage, and the bolt cutting holes here in issue.[13] The bolt-cutting feature was a commercial failure when incorporated into a tool which also contained a wire-cutter and a wire-stripper, but lacked the crimping pliers.[14] Hence the crimping pliers (not in issue in this case) appears to be responsi-

11. App. Pet. 13, 280 F. 2d 518 (7 Cir., 1960).
12. App. Pet. 15, 280 F. 2d 518, at 519.
13. See the physical exhibit, Pl. exh. 7; Pl. App. 25a.
14. Supplement to Def. App.; Pl. App. 26a.

ble for whatever commercial success respondent's tool may have achieved. No one has ever sold a threaded hand tool which is a bolt cutter and nothing else; nor has anyone ever manufactured or sold any of the four tools depicted in the Wenger patent drawings.[15]

(b) The trial court made no such finding, and indeed there is no evidence of record to that effect, but the Court of Appeals surmised that

> "Many thousands of mechanics over a period of nearly one hundred years had cut bolts and screws in the old, cumbersome, thread-damaging ways, yet did not come up with the solution shown by the patent in suit."[16]

Not even in the Wonderland of Oz has there ever been an industry devoted to manufacturing excessively long screws, so that "many thousands of mechanics" could be occupied in the symbiotic industry of cutting them down to size.

A far more reliable criterion is the test of contemporary evaluation by mechanics and those catering to mechanics. The mechanic Stevens independently conceived, made and used one tool constituting both the Grover rod cutter and the threaded bolt cutter later patented to respondent.[17] More than two years before respondent's patent issued, Stevens sold a drawing and description of his tool to *Popular Science* magazine for five dollars.[18] If a threaded bolt cutter was "the first and only significant breakthrough in bolt-cutting technique"[19] "over a period of two hundred years,"[19] which "many thousands of me-

15. Def. App. 6.
16. App. Pet. 18; 280 F. 2d 518, at 520-521.
17. Physical exhibits, Def. exhs. 2 and 1. Def. App. 14-18.
18. Def. App. 19; 14-15.
19. App. Pet. 15; 280 F. 2d 518, at 519.

chanics"[20] needed and were yearning for, as respondent persuaded the Court of Appeals to write, then surely the editors of *Popular Science* would have featured the Stevens bolt cutter actual size on the cover of the magazine, and described it in a leading article under the headline **AGE OLD PROBLEM SOLVED!** Instead, they gave it a small picture and one short paragraph, reproduced herewith,[21] which was inconspicuously placed toward the back of the magazine, as the last of eight trivial gadgets described in a section entitled "New Shop Ideas".

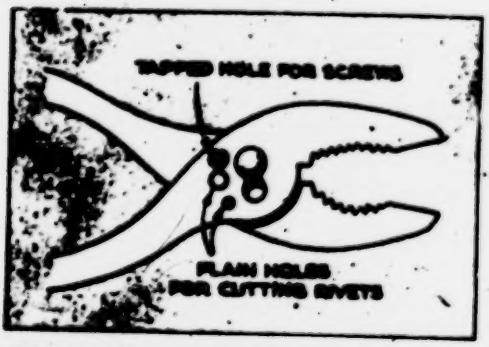
From the foregoing discussion, it is apparent that the Court of Appeals has rejected the constitutional standard of patentability, and on mere surmise has resuscitated an improvidently issued patent which the District Court had laid to rest with proper ceremonies.

---

20. App. Pet. 18; 280 F. 2d 518, at 520.

21. The Stevens "plain holes" constitute the prior art Grover construction and the "tapped hole" is the alleged invention in suit. The Stevens tool itself has been certified up to this Court, Def. Ex. 2.

DEFENDANT'S EXHIBIT NO. 1.



Pliers Cut Rivets and Screws. To clip small rivets and screws without damaging the ends, drill holes through both parts of a pair of ordinary pliers, locating the holes near the pivot. The holes should be drilled, of course, while the pliers are part way open. The pliers I use for this purpose have three holes of different sizes, one being threaded for an 8-32 screw. After a screw is turned in and clipped, the threads clean the end when it is removed.—*J. H. Stevens, Elizabeth City, N. C.*

APRIL 1949 215

Portion of page 215 of the April 1949 issue of Popular Science Monthly.

CONCLUSION.

It is a matter of prime public importance that there be one uniform law of the land in patent as in other federal constitutional matters. It is respectfully submitted that this case,—with an appendix record of only 116 pages, wherein the Court of Appeals discovered "inventive genius" in the simplest possible variation in a hole in a pair of pliers (one of the oldest and simplest hand tools)—is an appropriate one in which to settle the question whether under the Patent Act of 1952[22] ingenuity is still a prerequisite to patentability.

Petitioner therefore prays for a writ of certiorari.

Respectfully submitted,

ALBERT I. KEGAN,
79 West Monroe Street,
Chicago 3, Illinois,
Counsel for Petitioner.

22. 35 U. S. C. § 103 (July 19, 1952, c. 950, § 1; 66 Stat. 798).

APPENDIX.

IN THE UNITED STATES COURT OF APPEALS.

For the Seventh Circuit.

No. 12835 September Term, 1959—April Session, 1960.

AMP INCORPORATED,
Plaintiff-Appellant,
v.
VACO PRODUCTS CO.,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

June 28, 1960

Before DUFFY and KNOCH, *Circuit Judges*, and GRUBB, *District Judge*.

DUFFY, *Circuit Judge*. The complaint charges infringement of Wenger Patent No. 2,560,318 on a device for cutting bolts and screws. The District Court, by judgment, dismissed the suit declaring the patent invalid on the ground of obviousness, and also dismissed the charge of unfair competition. This appeal is from that part of the judgment dismissing the patent infringement count and declaring the patent to be invalid.

The patent in suit was issued on July 10, 1951, on application of Frank J. Wenger, filed July 6, 1948. Plaintiff became the owner of the patent by assignment. The patent relates to a tool for cutting bolts and screws to a desired length without damaging their threads.

Bolts and screws have been in common use at least since the so-called Industrial Revolution, about 1760. Many times a bolt or screw of a particular length is needed and not available. Various procedures and devices have been employed in the past for shortening available bolts and screws to a desired length. One method was cutting with a hack-saw. When smaller screws were used, side-cutting pliers could be used. Special tools of considerable size were utilized for cutting larger sized bolts and screws, many of them having guillotine-type cutting jaws.

The evidence in the record before us discloses that these prior methods and apparatus, when used, damaged the threads of the bolts and screws being cut. When a hack-saw was used, the threads adjacent to the cut were inevitably damaged, and burrs were usually formed. In using a commercial bolt cutter and side-cutting pliers, the ends of the threads were bent laterally, and the end of the bolt or screw was pinched to a "chisel point" described in the testimony as an overall shape comparable to that of the end of a pillow In the blunt-edged shearing device of the type shown in the Grover Patent No. 13570, the edges of the threads were flattened on one side.

After the threads were damaged by the cutting device, the bolts and screws could not be used until the threads had been "dressed" or restored to their original shape. This was often done by filing them with a sharp-cornered file. This was a time-consuming job, and unless done with care, the threads might easily be further damaged.

Another method used was to thread a nut on to the screw, and the screw was then cut behind the nut. The nut was then unthreaded from the screw for the purpose of causing the threads of the nut to reform the threads of the screw. Usually it took considerable force to remove the nut from the screw after the threads had been distorted. Hence, it often was necessary to hold the nut by

a vise or other comparable means. Added difficulty was caused by the fact the threads of the screw were usually of a harder material than the threads of the nut.

Plaintiff contends that although all previously known ways of shortening bolts and screws were clumsy and slow, no one, over a period of two hundred years, had been able to devise a better method until the Wenger invention. Plaintiff claims this invention represents the first and only significant break-through in bolt-cutting technique.

The patent in suit illustrates a pliers-type hand tool which consists of a pair of levers comprising jaw portions and handle portions. These levers are pivotally connected together by a pin. In the overlapping portions of the levers adjacent to the pivot pin are three cooperating pairs of holes. On one side, each of the three holes is threaded to receive the shank of a screw of a pre-determined size, while the matching hole in the other lever is of a larger diameter to freely receive the projecting portion of the screw.

After a screw is threaded through the first hole and into the opposite matching hole, the projected shank is sheared off cleanly by compressing the handles of the tool. The remaining portion of the screw can then be easily unthreaded. Since the threaded hole conforms accurately to the intricate shape of the threads of the shank of the screw, it distributes the shearing force uniformly throughout the entire surface of the screw and thus prevents damage. When the screw is removed from the tool, it is ready for immediate use without the necessity of "dressing" the threads.

Plaintiff acquired the invention in suit in 1948, and shortly thereafter placed on the market handtools incorporating the bolt and screw-cutting feature. The device met with commercial success. At the time of the trial, plaintiff was selling approximately 150,000 tools annually.

The United States Navy specified the patented bolt-cutting elements as standard equipment in certain types of hand tools.

In 1957, defendant added to its Model 1902 crimping pliers which had been on the market many years, bolt and screw-cutting elements practically identical to those in the plaintiff's tools. Defendant admits infringement if the patent is valid. Defendant does not deny that it incorporated the bolt and screw-cutting elements after having seen plaintiff's tools on the market.

In holding the patent in suit invalid, the District Court referred to Grover Patent No. 13570 which was issued in 1855. This patent had a pair of cooperating round holes for cutting wire. It could have been used to cut screws but, if so used, it would result in flattening the outer edges of the threads of the screw so that the threads would have to be "dressed" before the screws could be used.

The District Court found the only difference between the patented invention and the disclosure of the Grover Patent resided in threading one of the holes, and stated that this constituted an obvious change involving only "adoption of a well-known mechanical expedient." It is apparent such conclusion was the sole basis for the District Court's determination that the patent in suit was invalid.

There was also an attempt by defendant to prove prior invention and use by one Stevens. However, the District Court did not sustain this claim, and placed no reliance on the alleged prior public use by Stevens.

This is one of the few patent cases which has reached this Court where the sole patent relied on by the District Court was cited by the Patent Office and given full consideration during the prosecution of the application for the patent in suit.

In *Armour and Company* v. *Wilson & Co., Inc.*, 274 F. 2d

143, we discussed the question of obviousness in a patent suit. We said that what constitutes a patentable invention can be broken down into component parts, and that the final step was to determine whether the differences between the subject to be patented and the prior art would have been obvious to a person having an ordinary skill in the art. We said this called for the application of the correct legal criterion and was a question of law.

The Grover patent was issued in 1855 which was ninety-six years prior to the date of the patent in suit. That it was not obvious to provide a threaded hole for laterally supporting the threads of a screw or bolt adjacent to the plane along which such screw or bolt is being sheared is shown quite conclusively by the fact that for ninety-six years no one ever did conceive this idea despite the recognized need for some means of shortening bolts and screws without damage.

It is not accurate to say that the only change needed to convert the Grover tool into a tool of the type covered by the patent in suit, was the threading of one of the holes of the Grover tool. One hole would have to be threaded in a manner so that the threaded shank of the screw or bolt to be cut could be threaded into it. However, the other matching hole would have to be enlarged to permit the projecting portion of the screw to be received freely by it. These changes would adapt the tool only for the cutting of screws of a larger size than could have been cut with damage to the threads by the Grover tool before the changes were made.

The patent in suit does not claim threaded holes are novel *per se*. Instead, it claims the threaded hole as one of the elements in a novel combination designed to accomplish a result entirely different from the usual purposes of threaded holes, and a result which had not been accomplished by any device theretofore known.

The District Court apparently felt the invention was too simple to reach the level of inventiveness required for patentability. The handtool incorporating the invention of the patent in suit is admittedly of uncomplicated construction. But the fact that the solution was simple does not mean the solution was obvious. Many thousands of mechanics over a period of nearly one hundred years had cut bolts and screws in the old cumbersome thread-damaging ways, yet did not come up with the solution shown by the patent in suit.

Courts have rejected as a test of invention the apparent simplicity of an invention when viewed in retrospect. *Diamond Rubber Company* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428; *Goodyear Tire and Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279. In *Charles Peckat Mfg. Co.* v. *Jacobs*, 7 Cir., 178 F. 2d 794, 801, this Court said: "That Peckat's device now seems comparatively simple, of course, is no criterion of his invention. 'The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familiar with the subject: but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be sufficiently trusted to see what ought to be apparent to everyone.' (Citing cases)

Pertinent is the comment of this Court in *Pal Nation Co. etc.* v. *Lewin*, 7 Cir., 92 F. 2d 628, 630: "It is also insisted that the idea involved in appellee's device is so simple and obvious it does not constitute invention. True, it now has that appearance. The fact, however, that the improvement was long overlooked, using devices far less satisfactory, cannot be ignored."

35 U.S.C. §282 states, in part: "A patent shall be presumed valid. The burden of establishing invalidity of a

patent shall rest on a party asserting it." In the case at bar, the presumption of validity is extremely strong. The only prior art relied on by the District Court in its finding of invalidity was Grover Patent No. 13570. Under such circumstances, the courts have uniformly held that the presumption of validity is greatly reinforced.

As this Court stated in *Paragon-Revolute Corp.* v. *C. F. Pease Co.*, 239 F. 2d 746, 748: "The burden of proving a want of novelty is upon the party who avers it. 35 U.S.C. §282. The patent is *prima facie* valid. 35 U.S.C. §282. Furthermore, it is well settled that where the alleged invalidity is based upon a patent which was before the Patent Office and was rejected as an anticipation of the invention, the presumption of novelty and invention is greatly strengthened." Other decisions of this Court to the same effect are *Hunt* v. *Armour & Company*, 185 F. 2d 722, 726; *Copeman Laboratories Co.* v. *General Plastics Corp.*, 149 F. 2d 962, 964.

We think that Wenger made a significant contribution to the mechanical art by providing the first device in history capable of cutting bolts and screws without damaging their threads. This contribution is deserving of the protection of the patent laws, and we hold that Wenger Patent No. 2,560,318 is valid and was infringed.

Judgment

REVERSED AND REMANDED.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit,
Chicago 10, Illinois.

Tuesday, June 28, 1960.

Before:

Hon. F. Ryan Duffy, Circuit Judge,
Hon. Win G. Knoch, Circuit Judge,
Hon. Kenneth P. Grubb, District Judge.

AMP INCORPORATED,
Plaintiff-Appellant,
No. 12835 *vs.*
VACO PRODUCTS CO.,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby REVERSED, with costs and that this cause be, and it is hereby REMANDED to the said District Court, in accordance with the opinion of this Court filed this day.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit,
Chicago 10, Illinois.

Friday, August 12, 1960.

Before:

Hon. F. Ryan Duffy, Circuit Judge,
Hon. Win G. Knoch, Circuit Judge,
Hon. Kenneth P. Grubb, District Judge.

AMP INCORPORATED,
Plaintiff-Appellant,
No. 12835 *vs.*
VACO PRODUCTS CO.,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

It is ordered by the Court that the petition for a rehearing of this cause be, and the same is hereby, DENIED.

UNITED STATES COURT OF APPEALS

For the Seventh Circuit,

Chicago 10, Illinois.

Friday, August 12, 1960.

Before:

Hon. John S. Hastings, Chief Judge,
Hon. F. Ryan Duffy, Circuit Judge,
Hon. Elmer J. Schnackenberg, Circuit Judge,
Hon. Win G. Knoch, Circuit Judge,
Hon. Latham Castle, Circuit Judge.

AMP INCORPORATED,
Plaintiff-Appellant,
No. 12835 *vs.*
VACO PRODUCTS CO.,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

IT IS ORDERED by the Court that the petition for a rehearing *en banc* of this cause be, and the same is hereby, DENIED.

FILE COPY

Office Supreme Court, U.S.
FILED
NOV 23 1960
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 522

VACO PRODUCTS CO.,

Petitioner,

vs.

AMP INCORPORATED,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

TRUMAN S. SAFFORD
CURTIS, MORRIS & SAFFORD
530 Fifth Avenue
New York 36, N. Y.
Counsel for Respondent

Of Counsel:

WILLIAM C. CONNER
New York, N. Y.

WILLIAM J. KEATING
Harrisburg, Pa.

INDEX

	PAGE
QUESTION PRESENTED	1
STATUTE INVOLVED	2
STATEMENT OF THE CASE	2
ARGUMENT	7
CONCLUSION	14

TABLE OF AUTHORITIES

Statutes

35 U. S. C. § 103 — 2, 7

35 U. S. C. § 282 — 2, 7

Cases

A & P (Great A. & P. Tea Co. *v.* Supermarket Equipment Co.), 340 U. S. 147 (1950) — 7, 10

Charles Peckat Mfg. Co. *v.* Jacobs, 7 Cir., 178 F. 2d 794, 801 — 9

Diamond Rubber Company *v.* Consolidated Rubber Tire Co., 220 U. S. 428 — 9, 10

Goodyear Tire and Rubber Co. *v.* Ray-O-Vac Co., 321 U. S. 275, 279 — 9

Pearl *v.* Ocean Mills, 2 Bann. & Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2 — 10

Pyle National Co., etc. *v.* Lewin, 7 Cir., 92 F. 2d 628, 630 — 10

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 522

VACO PRODUCTS CO,

Petitioner,

vs.

AMP INCORPORATED,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Question Presented

Were the differences between the novel bolt cutter described and claimed in the Wenger U. S. patent No. 2,560,318 and the rod cutter disclosed in the 1855 Grover patent No. 13,570 such that the patented subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains?

Statute Involved

In addition to 35 U. S. C. § 103, which is set forth at page 3 of the Petition for Writ of Certiorari, the following statute is involved:

> 35 U. S. C. § 282. **Presumption of validity; defenses**—A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. * * * (July 19, 1952, c. 950, § 1, 66 Stat. 812).

Statement of the Case

The "Statement of the Case" presented at pages 3-6 of the Petition for Writ of Certiorari omits mention of the following significant facts, all of which are quoted from the Opinion of the Court of Appeals as set forth at pages 13 to 19 of the Petition:

The bolt cutter covered by the claims of the Wenger patent in suit ". . . provided the first device in history capable of cutting bolts and screws without damaging their threads." [Petition, p. 19]

> "Bolts and screws have been in common use at least since the so-called Industrial Revolution, about 1760. Many times a bolt or screw of a particular length is needed and not available. Various procedures and devices have been employed in the past for shortening available bolts and screws to a desired length. One method was cutting with a hacksaw. When smaller screws were used, side-cutting pliers could be used. Special tools of considerable size were utilized for cutting larger size bolts and screws, many of them having guillotine-type cutting jaws.

"The evidence in the record before us discloses that these prior methods and apparatus, when used, damage the threads of the bolts and screws being cut. When a hacksaw was used, the threads adjacent to the cut were inevitably damaged, and burrs were usually formed. In using a commercial bolt-cutter and side-cutting pliers, the ends of the threads were bent laterally, and the end of the bolt or screw was pinched to a 'chisel point' described in the testimony as an overall shape comparable to that of the end of a pillow. In the blunt-edged shearing device of the type shown in the Grover patent No. 13570, the edges of the threads were flattened on one side.

"After the threads were damaged by the cutting device, the bolts and screws could not be used until the threads had been 'dressed' or restored to their original shape. This was often done by filing them with a sharp-cornered file. This was a time-consuming job, and unless done with care, the threads might easily be further damaged." [Petition, p. 14]

In the use of the patented device, on the other hand, since the screw is supported in a threaded hole, which

"... conforms accurately to the intricate shape of the threads of the shank of the screw, it distributes the shearing force uniformly throughout the entire surface of the screw and thus prevents damage. When the screw is removed from the tool, it is ready for immediate use without the necessity of 'dressing' the threads." [Petition, p. 15]

"The device met with commercial success." [Petition, p. 15] "The United States Navy specified the patented bolt-cutting elements as standard equipment in certain types of hand tools." [Petition, p. 16]

> "Defendant does not deny that it incorporated the bolt and screw-cutting elements after having seen plaintiff's tools on the market." [Petition, p. 16]

> The Grover patent No. 13570 was "the sole patent relied on by the District Court . . ." This patent was "cited by the Patent Office and given full consideration during the prosecution of the application for the patent in suit." [Petition, p. 16]

In Petitioner's "Statement of the Case" there also are a number of significant *mis*statements:

1. On page 4 it is stated that

> "Since about 1935, it has been the common, usual practice of mechanics, when filing or cutting a screw, to retain it in a nut or similar threaded aperture which conforms to and supports the thread of the screw, to prevent the working force from flattening the thin edges of the screw against a flat surface."

There is no evidence supporting that statement. Petitioner cites page 39a of the Appendix to Respondent's Brief before the Court of Appeals. However, a reading of the cited portion of the record makes it clear that the testimony did not refer to the use of a nut to support the thread of the screw and prevent the working force from flattening the edges of the screw thread, as Petitioner states. Instead, it referred to the practice of "putting on the nut, then biting off the screw, then unscrewing the nut to dress it." The nut did not protect the edges of the screw thread from damage, but merely served as a crude die for reforming the threads after they had been damaged. This was the

practice which the Court of Appeals referred to in its Opinion as being subject to serious disadvantages:

> "Usually it took considerable force to remove the nut from the screw after the threads had been distorted. Hence, it often was necessary to hold the nut by a vise or other comparable means. Added difficulty was caused by the fact that the threads of the screw were usually of a harder material than the threads of the nut." [Petition, p. 14]

The last sentence refers to the fact that as the nut was unthreaded from the screw, the harder threads of the screw tended to enlarge and distort the threads of the nut, rather than being reformed by the threads of the nut. Thus, the threads of the screw were not restored to their original size and shape [Pl. App. 56a], and the screw could be used again only with the same nut whose threads had thus been enlarged.

2. On page 4, petitioner states

> "All that was necessary, therefore, to prevent Grover from flattening screw threads was to conform his screw-receiving hole to the shape of the screws."

As the Court of Appeals pointed out, this statement is incorrect:

> "It is not accurate to say that the only change needed to convert the Grover tool into a tool of the type covered by the patent in suit, was the threading of one of the holes of the Grover tool. One hole would have to be threaded in a manner so that the threaded shank of the screw or bolt to be cut could be threaded into it. However, the other matching hole would have to be enlarged to permit the projecting portion of the screw to be received freely by it." [Petition, p. 17]

Moreover, as the Court of Appeals further stated, these changes would not permit the tool to cut screws of the same small size which could have been cut in the tool before:

> "These changes would adapt the tool only for the cutting of screws of a larger size than could have been cut with damage to the threads by the Grover tool before the changes were made." [Petition, p. 17]

3. At page 5, the Petition states that the effect of the Court of Appeals' decision was ". . . to reinstate, after 79 years, a patent monopoly upon the entire combination comprising the [Grover] tool, of which the hole is but one part." The patent in suit has not reinstated the monopoly of the Grover patent. The claims of the patent in suit cover a new combination which is obviously different from that disclosed in the Grover patent. As the Court of Appeals stated in its Opinion,

> "The patent in suit does not claim threaded holes are novel *per se*. Instead, it claims the threaded hole as one of the elements in a novel combination designed to accomplish a result entirely different from the usual purpose of threaded holes, and a result which had not been accomplished by any device theretofore known." [Petition, p. 17]

4. On page 5 of the Petition, it is stated that "The Court of Appeals concluded that the District Court had not applied a sufficiently lenient standard of patentability . . ." This is a manifestly incorrect statement of the Court of Appeals' decision. The Court of Appeals reversed because the District Court had applied an *erroneous* test of invention based upon the apparent

simplicity of the invention when viewed in retrospect. As the Court of Appeals stated in its Opinion:

> "The District Court apparently felt that the invention was too simple to reach the level of inventiveness required for patentability . . . Courts have rejected as a test of invention the apparent simplicity of an invention when viewed in retrospect." [Petition, p. 18]

5. On pages 5 and 6, the Petition states that the Opinion of the Court of Appeals ". . . ignores the *A & P* case" and rejects "the standard consistently imposed by this Court." That is entirely wrong. The *A & P* case [340 U. S. 147 (1950)] was heavily relied on by Defendant-Petitioner in its Brief before the Court of Appeals [pp. 9, 10, 29, 31, 32] and was fully considered by that Court. However, the Court was convinced that the invention covered by the patent in suit met the standard of patentability established by the Supreme Court in that and other cases.

Argument

The present case presents no federal question of substance. Here, as in every patent case, we begin with the proposition that the patent is presumed to be valid [35 U. S. C. § 282]. The only defense which Petitioner raises is that defined by 35 U. S. C. § 103, under which defendant has the burden of showing that:

> ". . . the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which that subject matter pertains."

The evidence adduced at the trial and discussed by the Court of Appeals in its Opinion shows that during the two centuries in which bolts and screws have been in common use, it had been a frequent occurrence that a bolt or screw of a particular length was needed but was not available. Even amateur mechanics and do-it-yourself repairmen are frequently confronted with this problem.

Over the years, many procedures and devices were devised for shortening bolts and screws to the desired length. However, all of these prior methods had this common deficiency: they distorted the threads so that the bolt or screw could not be used until the threads had been "dressed" or restored to something approximating their original size and shape. This job of dressing the threads not only consumed appreciable time, but frequently resulted in further damaging the threads so that the bolt or screw could not be used. But for two centuries, the aggregate ingenuity of mankind had been unable to provide anything better.

Petitioner contends that it would have been "obvious" to thread one of the holes in a tool of the type shown in the 1855 Grover patent and enlarge the mating hole in order to construct a device of the type covered by the patent in suit. But the fact remains that in the 96 years after the Grover patent issued, during which countless thousands of mechanics used a tool of the type shown in the Grover patent for cutting bolts and screws, no one *did* conceive this idea. In the face of these undisputed facts, it seems impossible to conclude that the patented invention would have been "obvious . . . to a person having ordinary skill in the art."

The Petition for Writ of Certiorari does not cite any evidence, and indeed the record contains none, establishing the obviousness of the patented invention. Quite the contrary, the evidence strongly tends to establish its patentable ingenuity.

Petitioner's entire case is based upon the argument that the patented device is mechanically simple. In answering that argument, we do not believe we can improve upon the statement of the Court of Appeals in its Opinion:

> "The handtool incorporating the invention of the patent in suit is admittedly of uncomplicated construction. But the fact that the solution was simple does not mean the solution was obvious. Many thousands of mechanics over a period of nearly one hundred years had cut bolts and screws in the old cumbersome thread-damaging ways, yet did not come up with the solution shown by the patent in suit.
>
> "Courts have rejected as a test of invention the apparent simplicity of an invention when viewed in retrospect. *Diamond Rubber Company* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428; *Goodyear Tire and Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279. In *Charles Peckat Mfg. Co.* v. *Jacobs*, 7 Cir., 178 F. 2d 794, 801, this Court said: 'That Peckat's device now seems comparatively simple, of course, is no criterion of his invention. "The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familiar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be sufficiently trusted to see what ought to be apparent to everyone." (Citing cases)'

> "Pertinent is the comment of this Court in *Pyle National Co. etc.* v. *Lewin*, 7 Cir., 92 F. 2d 628, 630: 'It is also insisted that the idea involved in appellee's device is so simple and obvious it does not constitute invention. True, it now has that appearance. The fact, however, that this improvement was long overlooked, using devices far less satisfactory, cannot be ignored.' " [Petition, p. 18]

In the *Diamond Rubber Co.* case cited by the Court of Appeals, the U. S. Supreme Court laid the "hindsight" test to rest with an even more eloquent epitaph:

> "Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and 'in the light of the accomplished result,' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' *Pearl v. Ocean Mills*, 2 Bann. & Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2. Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not."

Petitioner contends the Court of Appeals rejected the decision of this Court in the *A & P* case [340 U. S. 147 (1950)] *sub silentio*. However, considering the repetitious and emphatic way in which Petitioner cited the *A & P* case before the Court of Appeals, it is obvious that the Court of Appeals was fully aware of the rule of this Court as laid down in the *A & P* case, and

merely found that rule inapplicable to the facts of the present case.

On page 8 of the Petition, it is argued that the commercial success which Respondent's tools have enjoyed is attributable not to the patented bolt-cutting feature but to other features of the tool. This argument is in direct conflict with the uncontradicted testimony. For example, Mr. Frank P. Mertes, who is a buyer for Sears Roebuck, testified that his company never purchased Respondent's tools until the bolt-cutting feature was added, and that it was the bolt-cutting feature which finally convinced Sears Roebuck to buy these tools [Pl. App. 46a].

On page 9 of the Petition, it is argued that

> "Not even in the Wonderland of Oz has there ever been an industry devoted to manufacturing excessively long screws so that 'many thousands of mechanics' could be occupied in the symbiotic industry of cutting them down to size."

That argument indicates the absurd extremes to which Petitioner has been extended in its attempts to belittle the invention. It is obvious that manufacturers of bolts and screws cannot anticipate all of the uses to which they will be put and, even if they could, they could not, as a practical matter, provide screws of all diameters in every length which could conceivably be desired. And, of course, no user could possibly stock all of these lengths. Instead, as the evidence shows, bolts and screws are manufactured in certain standard lengths. There arise many occasions, for example where the end of the bolt or screw which projects beyond the nut is exposed, where it might detract from

the appearance of a finished assembly or interfere with adjacent parts or create a safety hazard, when it is desirable to cut the bolt or screw so that its end is flush against the outer face of the nut.

Petitioner has strived mightily to make the patented invention appear trivial and useless. However, as the Court of Appeals pointed out in its Opinion [Petition, p. 16], "Defendant does not deny that it incorporated the bolt and screw-cutting elements after having seen plaintiff's tools on the market." The patented invention was not too trivial and useless for Petitioner to copy it and incorporate it into its existing hand tools to promote their sale. Petitioner's present depreciation of the invention is clearly something less than sincere.

Finally, on pages 9 and 10 of the Petition, it is argued that the obviousness of the patented invention is shown by the fact that when the mechanic Stevens later had a similar idea and submitted it to Popular Science Magazine, the magazine devoted only part of a page to it, rather than making it a lead article with a cover illustration. Although it seems unnecessary to answer this argument, which seems to have emanated from the "Wonderland of Oz" to which Petitioner has referred, a complete answer lies in the fact that the Stevens article was not published until sometime after Respondent's tools embodying the patented invention had gone into widespread commercial sale [Finding No. 7 of the District Court, p. 5a of Appendix to Plaintiff-Appellant's Brief before the Court of Appeals; and Opinion of the Court of Appeals, Petition, p. 15]. Under these circumstances, it is quite a tribute

to the invention that Popular Science Magazine still found it worthy of publication.

Incidentally, a quick reading of the last paragraph on page 9 of the Petition might give the impression that Stevens independently conceived the patented invention *before* the patentee Wenger did. This is directly contrary to the evidence and Finding 5 of the District Court [Pl. App. 5a]. Although Petitioner took no cross-appeal from that Finding, its Appeal Brief [pp. 25, 26] did refer to the alleged prior use by Stevens, which prompted the Court of Appeals in its Opinion to observe that this claim of prior use had not been sustained by the District Court [Petition, p. 16].

It thus appears that what we have here is a case in which the patented device was admittedly new, and constituted the first solution of a problem which had persisted for two centuries, which has enjoyed substantial commercial success, and which defendant has brazenly copied; a case in which the only prior art upon which Petitioner relies is a 96-year-old patent which had been cited and considered by the Patent Office prior to its allowance of the patent in suit. There not only seems to be ample support for the decision of the Court of Appeals, but any other decision would appear clearly erroneous.

This is not a case involving an important issue of constitutional law or even a difficult question of statutory interpretation on which the lower Federal Courts require guidance. Instead, it is just another case in which a disgruntled losing party wants another hearing before a different tribunal. It does not warrant the attention of this Court.

Conclusion

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

TRUMAN S. SAFFORD
CURTIS, MORRIS & SAFFORD
530 Fifth Avenue
New York 36, N. Y.
Counsel for Respondent

Of Counsel:

WILLIAM C. CONNER
New York, N. Y.

WILLIAM J. KEATING
Harrisburg, Pa.